

REMARKS

This Amendment and Response to Non-Final Office Action is being submitted in response to the non-final Office Action mailed January 24, 2006. Claims 21-37 are pending in the Application. The drawings stand rejected under 37 CFR 1.83(a). The specification stands rejected under 35 U.S.C. 112, first paragraph Claims 29-35 stand rejected under 35 U.S.C. 102(b) as being anticipated by Balne (U.S. Pat. No. 3,068,002). Claims 21-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Freymann (U.S. Pat. No. 2,009,695) in view of Balne (U.S. Pat. No. 3,068,002). Claim 27 stands rejected under 35 USC 103(a) as being unpatentable over Freymann (U.S. Pat. No. 2,009,695) in view of Balne (U.S. Pat. No. 3,068,002), and in further view of Davidson (U.S. Patent 5,674,159). Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Freymann (U.S. Pat. No. 2,009,695) in view of Balne (U.S. Pat. No. 3,068,002), and in further view of Goodwin (U.S. Patent 2,951,702). Claim 36 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Balne (U.S. Pat. No. 3,068,002) in view of Davidson (U.S. Patent 5,674,159). Claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Balne (U.S. Pat. No. 3,068,002) in view of Goodwin (U.S. Patent 2,951,702).

DRAWING OBJECTIONS

The Examiner objects to the drawings under 37 CFR 1.83(a). Specifically, the Examiner states that the drawings must show every feature of the invention specified in the claims. The Applicant has canceled claims 23-24 and 32-33. Applicant submits that the drawings are adequate. Withdrawal of this rejection is therefore respectfully requested.

Objection to the Specification Under 35 U.S.C. 112, First Paragraph:

The Examiner has objected to the Specification under 35 U.S.C. 112, first paragraph, as failing to provide an adequate written description of the invention. Applicant has canceled Claim 31, deleting the objectionable language. Withdrawal of the rejection is therefore respectfully requested.

The Examiner has also rejected Claims 30 and 31 under 35 U.S.C. 112, first paragraph, as failing to further limit the system of Claim 29. In response, the Applicant has amended Claim 30, and canceled Claim 31. Amended Claim 30 now recites:

30. (Currently Amended) The system of claim 30, further comprising a tension step-down, wherein in the event that the user suddenly and inadvertently releases the birthing aide, said wrist loops provide a momentary but gradual decrease of tension on elongated cord of the birthing aide.

In light of the amendments to the Claims, the Applicant submits that this rejection has been traversed, and its withdrawal is respectfully requested.

Rejection of Claims 29-35 Under 35 U.S.C. 102(b) - Balne

Claims 29-35 stand rejected under 35 U.S.C. 102(b) as being anticipated by Balne (U.S. Pat. No. 3,068,002). Specifically, the Examiner states that Balne “shows a device capable of functioning as a birthing aide to reduce the duration of the active labor process.” The Examiner admits that the claimed functionality is not disclosed in the Balne reference, however, the Examiner relies on the familiar case of *Ex parte Masham*. The Applicant respectfully disagrees with the Examiner’s conclusion.

The Applicant respectfully submits that the Examiner is misapplying *Ex parte Masham*. That case dealt with a claimed mixer for developer material, wherein the mixer was completely submerged in the material. The Applicant attempted to differentiate the claimed mixer from an identical prior art mixer based on the claimed mixer’s intent to work on separate materials. There, the court correctly pointed out, and as the Examiner quotes, “a recitation with respect to the manner in which a claimed *apparatus* is intended to be employed does not differentiate the claimed *apparatus* from a prior art *apparatus* satisfying the claimed structural limitations” (emphasis added).

Applicant is well aware of the teaching of *Masham* and its related line of cases where claims to a *composition* or *apparatus* are held unpatentable when a new use for an existing *composition* or *apparatus* is found.¹ Each of these cases dealt with a claimed

¹ See e.g., *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) (“The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition.”); *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985) (composition claim reciting a newly discovered property of an old alloy did not satisfy section 102 because the alloy itself was not new); *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) (intended use of an old composition does not render composition claim patentable); *In re Zierden*, 411 F.2d 1325, 1328, 162 USPQ 102, 104 (CCPA 1969) (“[M]ere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable.”); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim failed to distinguish over the prior art apparatus); *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 162 (CCPA 1957) (“the grant of a patent on a composition or a machine cannot be predicated on a new use of that machine or composition”); *In re Benner*, 174 F.2d 938, 942, 82 USPQ 49, 53 (CCPA 1949) (“no provision has been made in the patent statutes for granting a patent upon an old product based solely upon discovery of a new use for such product”).

composition or *apparatus*. However, these cases and their teachings are inapplicable where the Applicant does not claim the *composition* or *apparatus*.

In re Hack recognized that the discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using.² In *Hack*, the claims at issue were drawn to a brazing alloy composed of particular percentages of gold, copper and nickel. The court held that such an alloy was taught in the prior art but recognized that the discoverer of a new use with a known product can patent his discovery using process or method claims, but not product claims. Other courts have also stated that one who discovers a new use for a known product may be able to obtain a patent to a method of using that known product, provided that the discovery meets other conditions of patentability.³

The claims of the present application are not directed to the apparatus, which is the extent of the holding in *Ex Parte Masham*. The legal rule of *Ex Parte Masham* would have been applicable if the Applicants were claiming an apparatus. The claims of the present application however are directed to a method “for lessening the duration of the active labor and pushing stages of childbirth.” Because the claims are limited to a method, *Ex Parte Masham* is inapplicable. If the Examiner is stating that the structure in Balne ‘002 anticipates the Applicant’s method, then this situation is analogous to *Hack*, not *Masham*.

² *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957), 245 F.2d 246, 248 (C.C.P.A. 1957) (holding product claims anticipated but recognizing patentability of new process with known product).

³ See *In re Marshall*, 578 F.2d 301, 304 (C.C.P.A. 1978) (holding weight control process claims with known compound patentable). In *Marshall*, the applicant’s claims were directed to a weight control process utilizing an anesthetic, such as oxethazaine, to inhibit the release of hormones and pancreatic enzymes involved in the digestion of food. *Id.* at 302-03. The cited prior art reference, the Physician’s Desk Reference (PDR), disclosed drugs containing oxethazaine, which could be used to treat esophagitis, gastritis, peptic ulcer and irritable bowel syndrome. *Id.* at 303. The court held that the reference did not anticipate the method claims because the PDR did not disclose anything remotely close to suggesting taking oxethazaine to lose weight. *Id.* As stated by the court, “[i]f anyone ever lost weight by following the PDR teachings it was an unrecognized accident..

As explained in *In re Marshall* and stated above, one who discovers a new use for a known product may be able to obtain a patent to a method of using that known product, provided that the discovery meets other conditions of patentability. With regard to prior art, that “other condition” is obviousness.

The presently claimed method is wholly unobvious in light of the Balne ‘002 reference. Balne ‘002 discloses an “exercise apparatus in which a pair of handles are grasped by the user and pushed or pulled against resistance force to exercise and develop the muscles of the body.”

The Applicant’s independent Claim 21 begins: A method for lessening the active labor and pushing stages of childbirth....” There is absolutely nothing in Balne ‘002 that would disclose, anticipate, or suggest a method for “for lessening the active labor and pushing stages of childbirth.”

Furthermore, Claim 21 recites the step of “inserting a user’s wrists through said wrist loops, and grasping said birthing aide in the vicinity of said handhold.” There is nothing in Balne ‘002 that would anticipate this limitation either. Balne ‘002 discloses handles which the user may grasp with his hand, not wrist loops for a user to insert her hands through.

The Examiner states that a user is “capable of inserting her wrists into aid wrist loops , grasping the birthing aide in the vicinity of said handhold knob and pulling against the source of resistance.” Applicant respectfully submits that this “capable of” test that the Examiner recites is not the standard for obviousness.

Balne does not disclose a birthing aide. Balne does not disclose inserting a user’s wrists through wrist loops and then grasping a handhold. Therefore, Balne ‘002 cannot sustain the Examiner’s current rejection. The Applicant respectfully submits that this

rejection is therefore traversed. Withdrawal of the current rejection is therefore respectfully requested.

Rejection of Claims 21-26 Under 35 U.S.C. 103(a) – Freymann & Balne

Claims 21-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Freymann (U.S. Pat. No. 2,009,695) in view of Balne (U.S. Pat. No. 3,068,002). The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to join the cord of Freymann into a pair of rope v-arms as taught by Balne so that pulling forces would be uniform on one central cord.

Freymann '655 discloses a restraining device, not a birthing aide for "lessening the duration of the active labor and pushing stages of child birth." According to Freymann, the "appliance thus described will be appreciated as a humane method for gently restraining the misdirected activities... of an obstetrical patient...."⁴ The device should be "used in pairs" to hold "the hands of a patient... experiencing pains incident to child birth [with] a pair of straps being provided for said appliances... to be secured to the foot of the surgeon's operating table, obstetrical delivery table, labor bed or other support on which the patient reclines...."⁵ Freymann goes on to state that the device can be used "as a surgical appliance in all instances when, in the opinion of the surgeon, it is considered advisable or necessary to prevent manual interference on the part of a patient with the activities of the surgeon during the progress of an operation...."

The Applicant submits that, contrary to the Examiner's assertion, Freymann does not disclose a method of lessening labor duration, but rather a method of restraining an obstetrical or surgical patient to prevent their movement. Applicant therefore submits that Freymann is not a valid reference.

⁴ US Pat No 2009655, Col. 3, lines 24-29.

⁵ Id., Col. 1, lines 1-11.

Furthermore, the Applicant respectfully submits that the Examiner's stated motivation to combine these references does not appear anywhere in the references, and therefore is not obvious to one of ordinary skill in the art under the *Graham v. John Deere* standards. The Examiner states that it would be obvious to combine Freymann with Balne so that pulling forces would be uniform on one central cord. Applicant respectfully disagrees.

Freymann states that the patients hands should be restrained so as to prevent interference with the surgery.⁶ To further this, Freymann requires that the device be used in pairs.⁷ Thus, combining Freymann with Balne to result in a uniform central cord is directly contrary to the teachings of Freymann. The Applicant respectfully reminds the Examiner that it is improper to combine references where the references teach away from their combination.⁸

Furthermore, combining the references to result in a single central cord would frustrate the purpose of Freymann, which is to restrain the hands so as to prevent interference with the surgical or obstetrical procedure. A central cord in Freymann would place the obstetrical patient's hands directly into the area which Freymann is trying to avoid. Applicant points out that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.⁹

As the Applicant has respectfully pointed out, the combination of Freymann and Balne is improper. Thus, the current rejection cannot be sustained. The Applicant

⁶ Id., Col. 3, lines 24-29.

⁷ Id., Col. 1, lines 1-11.

⁸ *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

⁹ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

respectfully submits that this rejection has been traversed, and its immediate withdrawal is therefore respectfully requested.

Rejection of Claim 27 Under 35 U.S.C. 103(a) – Freymann, Balne, & Davidson

Claim 27 stands rejected under 35 USC 103(a) as being unpatentable over Freymann (U.S. Pat. No. 2,009,695) in view of Balne (U.S. Pat. No. 3,068,002), and in further view of Davidson (U.S. Patent 5,674,159). The Examiner admits that the Freymann/Balne combination is silent as to a rope made of synthetic fiber selected from the listed group, and instead relies on Davidson to disclose this limitation.

As pointed out above, the combination of Freymann and Balne is unobvious because: 1) the references are from different fields of endeavor; 2) Freymann teaches away from a single central cord; and 3) combining the references into a single central cord would frustrate the purpose of Freymann, which is to restrain the hands so as to prevent interference with the surgical or obstetrical procedure. Claim 27 depends from claim 26, and therefore the comments made in regard to claim 26 are applicable here as well. The combination of Freymann and Balne is improper. The current rejection cannot be sustained under the *Graham* standards. The Applicant respectfully submits that this rejection has been traversed, and its immediate withdrawal is therefore respectfully requested.

Rejection of Claim 28 Under 35 U.S.C. 103(a) – Freymann, Balne, & Goodwin

Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Freymann (U.S. Pat. No. 2,009,695) in view of Balne (U.S. Pat. No. 3,068,002), and in further view of Goodwin (U.S. Patent 2,951,702). The Examiner admits that the Freymann/Balne combination is silent as to a rope made of synthetic fiber selected from the listed group, and instead relies on Goodwin to disclose this limitation.

As pointed out above, the combination of Freymann and Balne is unobvious because: 1) the references are from different fields of endeavor; 2) Freymann teaches away from a single central cord; and 3) combining the references into a single central cord would frustrate the purpose of Freymann, which is to restrain the hands so as to prevent interference with the surgical or obstetrical procedure. Claim 27 depends from claim 26, and therefore the comments made in regard to claim 26 are applicable here as well. The combination of Freymann and Balne is improper. The current rejection cannot be sustained under the *Graham* standards. The Applicant respectfully submits that this rejection has been traversed, and its immediate withdrawal is therefore respectfully requested.

Rejection of Claim 36 Under 35 U.S.C. 103(a) – Balne & Davidson

Claim 36 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Balne (U.S. Pat. No. 3,068,002) in view of Davidson (U.S. Patent 5,674,159). The Examiner admits that Balne is silent as to a rope made of synthetic fiber selected from the listed group, and instead relies on Davidson to disclose this limitation.

Claim 36 depends from Claim 29. As stated above, the Applicant's claimed system is not obvious over Balne. Furthermore, the disclosure of Davidson does not overcome the deficiencies pointed out by the Applicant in the Balne reference. Therefore, the current rejection cannot be sustained under the *Graham* standards. The Applicant respectfully submits that this rejection has been traversed, and its immediate withdrawal is therefore respectfully requested.

Rejection of Claim 37 Under 35 U.S.C. 103(a) – Balne & Goodwin

Claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Balne (U.S. Pat. No. 3,068,002) in view of Goodwin (U.S. Patent 2,951,702). The Examiner

admits that Balne is silent as to a rope made of synthetic fiber selected from the listed group, and instead relies on Goodwin to disclose this limitation.

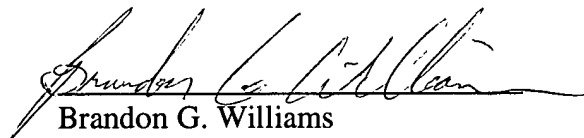
Claim 37 depends from Claim 29. As stated above, the Applicant's claimed system is not obvious over Balne. Furthermore, the disclosure of Goodwin does not overcome the deficiencies pointed out by the Applicant in the Balne reference. Therefore, the current rejection cannot be sustained under the *Graham* standards. The Applicant respectfully submits that this rejection has been traversed, and its immediate withdrawal is therefore respectfully requested.

CONCLUSION

Applicant would like to thank Examiner for the attention and consideration accorded the present Application. Should Examiner determine that any further action is necessary to place the Application in condition for allowance, Examiner is encouraged to contact undersigned Counsel at the telephone number, facsimile number, address, or email address provided below. It is not believed that any fees for additional claims, extensions of time, or the like are required beyond those that may otherwise be indicated in the documents accompanying this paper. However, if such additional fees are required, Examiner is encouraged to notify undersigned Counsel at Examiner's earliest convenience.

Respectfully submitted,

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